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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,414	12/28/2000	Michael Andrew Cook	03-LO-6803	6941

7590

04/08/2003

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EXAMINER

CUEVAS, PEDRO J

ART UNIT

PAPER NUMBER

2834

DATE MAILED: 04/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary****Application No.**

09/750,414

**Applicant(s)**

COOK ET AL.

**Examiner**

Pedro J. Cuevas

**Art Unit**

2834

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 6-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 6 and 8-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,113,104 to Blaettner et al. in view of JP Patent No. 62-018939 to Yuji.

Blaettner et al. discloses motor comprising:

a motor housing (22) comprising an end cap and a can, said end cap connected to said can and comprising an opening, said can comprising an opening;

a stator assembly (24) positioned within said motor housing and comprising a stator core and a stator bore extending therethrough, said stator core comprising a plurality of stator windings (magnets in this particular case, since in the patent the motor is used as a generator);

a rotor assembly (26) positioned within said stator bore, said rotor assembly comprising a rotor core, a rotor bore disposed through said rotor core, and a rotor shaft extending through said rotor bore, said end cap opening, and said can opening;

a bearing (60) positioned on said rotor shaft adjacent said end cap, and

a washer (164) positioned on said rotor shaft and in contact with said bearing.

However, it fails to disclose a washer comprising a first layer, a second layer and a third layer, said second layer different from said first and third layers, said washer configured to dampen vibrations induced from said rotor shaft.

Yuji teaches the construction of a washer (9) comprising a first layer (9a), a second layer (9b) and a third layer (9c), all bonded together, said second layer different from said first and third layers for the purpose of protecting insulator layer (9b) from the external force applied in fastening the bolt (8), thus the short circuit can be broken between the casing, bolt and motor stator end face, so that the characteristics of the motor can be displayed effectively without obstructing the electromagnetic induction.

It would have been obvious to one skilled in the art at the time the invention was made to use the washer disclosed by Yuji on the motor disclosed by Blaettner et al. for the purpose of protecting insulator layer (9b) from the external force applied in fastening the bolt (8), thus the short circuit can be broken between the casing, bolt and motor stator end face, so that the characteristics of the motor can be displayed effectively without obstructing the electromagnetic induction.

It should be emphasized that "apparatus claims must be structurally distinguishable from the prior art." MPEP 2114. In re Danly, 263 F. 2d 844, 847, 120 USPQ 528, 531 (CCPA 1959) it was held that apparatus claims must be distinguished from prior art in terms of structure rather than function. In Hewlett-Packard Co v Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990), the court held that: "Apparatus claims cover what a device is, not what it does." (emphases in original). To emphasize the point further, the court added: "An

invention need not operate differently than the prior art to be patentable, but need only be different" (emphases in original).

3. Claims 7 and 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,113,104 to Blaettner et al. in view of JP Patent No. 62-018939 to Yuji as applied to claims 6 and 8-13 above, and further in view of U.S. Patent No. 4,340,830 to Hoyer-Ellefsen.

Blaettner et al. in view of Yuji discloses a motor as described above having a washer assembly, which reduces vibrational stresses induced from the rotor shaft when the rotor shaft contacts said bearing during rotation of the rotor shaft.

However, it fails to disclose a motor further comprising a snap ring affixed to said shaft, said washer adjacent said snap ring.

Hoyer-Ellefsen teaches the use of a snap ring (76) affixed to a shaft for the purpose of exerting a controlled pressure on the bearing members (58, 60) by the resilient washer (72) that permits free rotation of rotor (48) and shaft (50).

It would have been obvious to one skilled in the art at the time the invention was made to use the snap ring disclosed by Hoyer-Ellefsen on the motor disclosed by Blaettner et al. in view of Yuji for the purpose of exerting a controlled pressure on the bearing members (58, 60) by the resilient washer (72) that permits free rotation of rotor (48) and shaft (50).

4. With regards to claim 16, Blaettner et al. in view of Yuji discloses a washer assembly wherein said damping washer second layer is located between said damping washer first and third layers, said washer assembly positioned on the rotor shaft adjacent the bearing as shown in Figure 1.

5. With regards to claims 8, 10-13, 15, 17 and 18, Yuji discloses a washer assembly as claimed except for the combination of materials to construct the washer as claimed.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to select the materials in the claims to construct the washer since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

#### ***Response to Arguments***

6. Applicant's arguments filed February 28, 2003 have been fully considered but they are not persuasive.

7. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the washer disclosed by Yuji is combined with the teachings of Blaettner et al. for the purpose of providing a three-layer washer for the dynamoelectric machine.

8. In response to applicant's argument that the claimed bearing is used to dampen vibrations, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use,

then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

9. In response to applicant's arguments against the references individually, one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

#### **Conclusion**


10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro J. Cuevas whose telephone number is (703) 308-4904. The examiner can normally be reached on M-F from 8:30 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nestor R. Ramirez can be reached on (703) 308-1371. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-1341 for regular communications and (703) 305-3432 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Pedro J. Cuevas  
April 2, 2003

  
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